

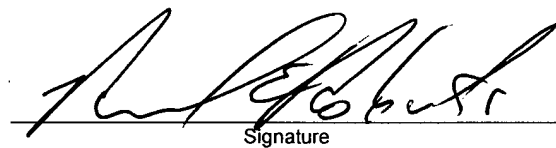
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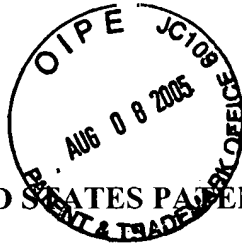
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		60154.302001	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>4 August 2005</u></p> <p>Signature <u>Patricia Bielmann</u></p> <p>Typed or printed name <u>Pat Bielmann</u></p>		Application Number	Filed
		10/053,508	11/10/2005
		First Named Inventor	
		TSAL, John C.	
		Art Unit	Examiner
		2877	LYONS, Michael A
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record.      38,597 Registration number</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</p> <p> Signature Raymond E. Roberts Typed or printed name (408) 558-9950 Telephone number 4 August 2005 Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: **TSAL, John C.**  
For (title): **ROTATION AND TRANSLATION MEASUREMENT**

Filing Date: **11/10/2001**  
Serial No: **10/053,508**

Examiner: **LYONS, Michael A.**  
Art Unit: **2877**

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**  
**(Attached Sheets Containing Remarks And Arguments)**

Claims 1-20 are rejected under §103(a) based on U.S. Pat. No. 4,714,339 by Lau et al. in view of U.S. Pat. No. 5,521,704 by Thiel et al. Claims 1, 12 and 17 are independent, but similar, aside from being drawn to apparatus, means-plus-function based apparatus, and method. We do not discuss the dependent claims herein.

The Examiner's main position is covered in the Action dated 03/08/2005. Applicant's key points are covered in the response dated 05/18/2005, starting on pg. 6 at the text "**Regarding claims 1, 12, and 17 ...**" and ending on pg. 8 before the text "**Regarding claims 11, 16 ....**" Our remarks cover in detail why the combination of Lau and Thiel cannot support a *prima facie* case for obviousness. We respectfully ask that these short remarks be read now and that the following clarification and summarization be considered.

Our statement that "*Lau ... teaches a 'tracking mirror 28 ... under servo control [by] the x-axis output [and the Y-axis output] of the photodiode 128'*" (pg. 6, after the 1<sup>st</sup> block quote) expresses that Lau has essential elements with no equivalent in the claimed invention. This rebuts the argument that the claimed invention is "*mere duplication of the essential working parts of a device.*" Lau cannot perform its role without this and there is no motivation to duplicate the entirety of Lau because that adds no benefit. The relevant embodiment of Lau uses one complex channel for XYZ-axis relative measurement. The claimed invention uses two simpler channels to permit measuring these and two of roll, pitch, and yaw (and even absolute measurement with dependent claim elements). The Examiner has wrongly found duplication and confused it with what is actually a principles of operation difference between the inventions.

Our statement in the next paragraph, which reads:

*Continuing, ... "Thiel (Fig. 1) discloses a measuring apparatus and corresponding method with a pair of optical channels 3 and 4 that allows for measurement of two locations on the test object." Again, we agree, but urge that this and Lau is not determinative ....*

should be taken with our latter statement "*The Action mischaracterizes Thiel as having two channels. Thiel only works by virtue of having two sets of interferometers that have fixed known separation, and thus is more correctly regarded as being a single channel.*" (pg. 8, 1<sup>st</sup> full ¶).

The Examiner's counter argument appears in the Action dated 06/17/2005, where the Response to Arguments section (pg. 4) states:

*The thrust of the applicant's arguments center around the fact that the combined device of Lau and Thiel as discussed above is in error because the combined device fails to disclose the multiple-axis (as argued, 5-axis) measurement of the instant invention. However, nowhere in the claim language is such a measurement disclosed. ...*

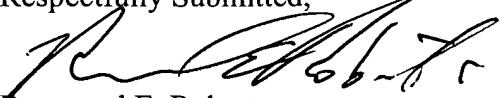
The Examiner mistakenly has taken our supporting comments about 5-axis measurement as central, but he is correct that we feel that this does not need to be recited. To recite "*5-axis measurement*" is to risk claim interpretation in the courts limiting to such, so that 3- or 4-axis measurement using the same apparatus or method is not infringement. Absent a need to avoid prior art, an applicant would be unwise to add claim language reciting benefits in addition to the structure or steps to achieve those benefits. We have pointed out our belief that U.S. law does not require this of us and asked the Examiner to cite authority otherwise. He has not done so.

There is also no need to amend the claims as suggested to avoid prior art, because the *prima facie* case for obviousness has three major criteria and all three must be met. The first is that there be a suggestion or motivation to combine references and the second is that doing so produce a result having some reasonable expectation of success. Respectfully, if a set of references are not usable under these first two criteria, what a set of claims actually recites becomes irrelevant. In the present case, however, we have submitted remarks about how the first two criteria are not met, and how this is un-rebutted, and we have gone ahead and submitted remarks about how the third criteria is also not met.

Finally, please also review our remarks in the response dated 07/13/2005. These barely cover two pages, and cover how the rejection appears to be based on unsupported Official Notice or improper use of U.S. Pat. No. 3,738,754 by Marcy et al.

Intellectual Property Law Offices  
1901 S. Bascom Ave., Suite 660  
Campbell, CA 95008  
Telephone: 408.558.9950  
Facsimile: 408.558.9960

Respectfully Submitted,

  
Raymond E. Roberts  
Reg. No.: 38,597